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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
40987	7590	04/04/2008	EXAMINER	
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			FRITZ, BRADFORD F	
ART UNIT	PAPER NUMBER			
	2141			
MAIL DATE	DELIVERY MODE			
04/04/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>		<b>Application No.</b>	<b>Applicant(s)</b>
10/726,719		THUERK, KEITH A.	
<b>Examiner</b>	<b>Art Unit</b>		
BRADFORD F. FRITZ	2141		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 04 January 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-5,8,10-15,18 and 20-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,8,10-15,18 and 20-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 01/04/2008 have been fully considered but they are not persuasive.
2. In the remarks, applicant argued in substance that:

(A) Prior art does not teach selecting a group of subscribers and designating an action to be taken for a subscriber in the group in response to a status change of the subscriber.

As to point (A), Wick teaches selecting a group of subscribers (Fig. 4) and designating an action to be taken for a subscriber in the group in response to a status change of the subscriber (column 5, lines 6-55 and Fig. 5). Wick teaches "selecting a group of subscribers" because the user selects a group of users, the users which form the buddy list, the entire buddy list is selecting a group and Wick even teaches selecting subgroups inside the entire group of buddies (Fig. 4). The Examiner notes that the claims do not require performing an action to more than one member of the group, as claimed, the action applies only to a single subscriber within a group of subscribers (the buddy list), which is disclosed by Wick.

(B) Prior art does not teach that the designated action or rule can be applied to any group of pounces.

As to point (B), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the designated action or rule can be applied to any group of pounces") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) Prior art does not teach grouping pounces together or designating a single action to multiple subscribers.

As to point (C), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "teach grouping pounces together or designating a single action to multiple subscribers") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(D) Prior art does not teach a system or method in which actions can be designated for groups and for individual subscribers.

As to point (D), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a system or method in which actions can be designated for groups and for individual subscribers") are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(E) Prior art does not teach setting up two levels of actions and that Wick only discloses a single action or event for a single pounce.

As to point (E), Wick teaches setting up two levels of actions (column 5, lines 1-6 and Fig. 5 and 8). The Examiner notes that Wick even teaches setting up at least five different levels of actions (Figures 5 and 8).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 8, 10-14, 18, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wick (6,691,162).

5. Regarding claims 1, 11, and 21, Wick disclosed selecting a group of subscribers of an instant messaging service (column 5, lines 6-55 and Fig. 5), designating at least one action for an instant messaging client to automatically perform in response to a

state of a subscriber changing to a specified state (column 5, lines 6-55 and Fig. 5); associating said designated action with said group (column 5, lines 6-55 and Fig. 5 and 4); automatically detecting that a state change of at least one of said subscribers in said group is specified (column 5, lines 6-55 and Fig. 5); and automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step (column 5, lines 6-55 and Fig. 5).

6. Regarding claims 2 and 12, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between said client and said at least one subscriber (column 5, lines 6-55 and Fig. 5).

7. Regarding claims 3 and 13, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).

8. Regarding claims 4 and 14, Wick disclosed wherein said selecting, said designating, said associating, said detecting, and said executing steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).

9. Regarding claims 8 and 18, Wick disclosed wherein said specified state change results from a state change for said at least one subscriber from one or more possible inactive states to one or more active states (column 5, lines 6-55 and Fig. 5).

10. Regarding claims 10 and 20, Wick disclosed presenting within a graphical user interface a list of said subscribers (column 5, lines 6-55 and Fig. 5), and within said

graphical user interface (Fig. 4-5), visually distinguishing said at least one subscriber from other subscribers in said list (column 5, lines 6-55 and Fig. 5).

11. Regarding claims 22 and 23, Wick disclosed determining that a group of subscribers of an instant messaging system have a status of being currently unavailable for instant message communications (column 5, lines 6-55 and Fig. 5); indicating an intention to communicate with any of the subscribers as any of the subscribers become available (column 5, lines 6-55 and Fig. 5); automatically detecting a status change resulting in at least one of said subscribers becoming available for an instant message communications (column 5, lines 6-55 and Fig. 5); and automatically initiating an instant messaging session that includes said subscribers in said group and said client responsive to said status change (column 5, lines 6-55 and Fig. 5).

12. Regarding claim 24, Wick disclosed designating at least one other action for an instant messaging client to automatically perform in response to a state of a specific subscriber in said group changing to another specified state (column 5, lines 1-10 and Figs. 5 and 8); automatically detecting that a state change for said specific subscriber is the other specified state (column 5, lines 6-55 and Fig. 5); and automatically executing said other designated action responsive to said detecting step (column 5, lines 6-55 and Fig. 5).

13. Regarding claim 25, Wick disclosed indicating an intention to communicate with a specific one of said subscribers only in response to a state of said specific subscriber changing to a specific available state (column 5, lines 6-55 and Fig. 5); and responsive to said status change resulting in said specific subscriber becoming available (column 5,

lines 6-55 and Fig. 5), excluding said specific subscriber from said instant messaging session unless said status change indicates the state of said specific subscriber has changed to said specific state (column 5, lines 6-55 and Fig. 5).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

16. Regarding claims 5 and 15, Wick disclosed the invention as described above. However, Wick does not explicitly teach wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the system of Wick because both Wick and Ogle are from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another popular IM client.

***Conclusion***

The prior art made of record and not relied upon by Examiner is considered pertinent to the Applicant's disclosure.

**a. Aravamudan et al. (6,301,609) teaches an instant messaging system where a user can set up group level rules in order to automatically perform specific actions when a member of that group changes state.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. F. F./  
Examiner, Art Unit 2141

/Andrew Caldwell/  
Supervisory Patent Examiner, Art Unit 2142